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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,112	06/24/2002	Lars Egnell	CISCP728C1	9119
26541	7590	07/14/2004	EXAMINER	
RITTER, LANG & KAPLAN 12930 SARATOGA AE. SUITE D1 SARATOGA, CA 95070			KAO, CHIH CHENG G	
			ART UNIT	PAPER NUMBER
			2882	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/089,112	EGNELL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chih-Cheng Glen Kao	2882	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2004 and 26 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-7 and 9-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7, 9, 10 and 12-14 is/are allowed.
- 6) ☒ Claim(s) 15, 19, 21, 22, 26, 28, 29, 33 and 35 is/are rejected.
- 7) ☒ Claim(s) 11, 16-18, 20, 23-25, 27, 30-32 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/26/02, 1/26/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

1. Claims 2, 6, 10-14, 16, 19, 20, 23, 26-28, 30, 31, and 34 are objected to because of the following informalities, which appear to be minor draft errors including grammatical and lack of antecedent basis problems.

In the following format (location of objection; suggestion for correction), the following suggestions may obviate their respective objections: (claim 2, line 7, "the add/drop modules are arranged"; inserting - -and in that- - before "the add/drop modules"), (claim 2, line 8, "the add/drop modules of a first one of the two sets"; inserting - -at least- - before "two add/drop modules" in line 3), (claim 6, line 2, "house"; replacing "house" with - -housing- -), (claim 6, line 3, "house"; replacing "house" with - -housing- -), (claim 6, line 4, "house"; replacing "house" with - -housing- -), (claim 6, line 7, "house"; replacing "house" with - -housing- -), (claim 6, line 8, "house"; replacing "house" with - -housing- -), (claim 10, line 4, "and hat for one"; replacing "hat" with - -that- -), (claim 10, line 4, "two end ad/drop"; replacing "ad/drop" with - -add/drop- -), (claim 10, line 5, "an input o the add"; replacing "o" with - -of- -), (claim 11, line 2, "house"; replacing "house" with - -housing- -), (claim 11, line 3, "house"; replacing "house" with - -housing- -), (claim 11, line 4, "house"; replacing "house" with - -housing- -), (claim 11, line 7, "house"; replacing "house" with - -housing- -), (claim 11, line 8, "house"; replacing "house" with - -housing- -), (claim 12, line 2, "house"; replacing "house" with - -housing- -), (claim 12, line 3, "house"; replacing "house" with - -housing- -), (claim 12, line 4, "house"; replacing "house" with - -housing- -), (claim 12, line 7, "house"; replacing "house"

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with - -housing- -), (claim 12, line 8, "house"; replacing "house" with - -housing- -), (claim 13, line 2, "house"; replacing "house" with - -housing- -), (claim 13, line 3, "house"; replacing "house" with - -housing- -), (claim 13, line 4, "house"; replacing "house" with - -housing- -), (claim 13, line 7, "house"; replacing "house" with - -housing- -), (claim 13, line 8, "house"; replacing "house" with - -housing- -), (claim 14, line 2, "house"; replacing "house" with - -housing- -), (claim 14, line 3, "house"; replacing "house" with - -housing- -), (claim 14, line 4, "house"; replacing "house" with - -housing- -), (claim 14, line 7, "house"; replacing "house" with - -housing- -), (claim 14, line 8, "house"; replacing "house" with - -housing- -), (claim 16, line 4, "to the one fiber path"; deleting "the"), (claim 19, line 3, "a control signal, and a tap"; deleting the comma), (claim 20, line 2, "the housing"; deleting "the"), (claim 23, line 3, "then drop device"; replacing "then" with - -the- -), (claim 23, line 4, "to the one fiber path"; deleting "the"), (claim 26, line 4, "a control signal, and a tap"; deleting the comma), (claim 27, line 2, "to the housing"; deleting "the"), (claim 28, line 2, "the add/drop node"; replacing "node" with - -nodes- -), (claim 30, line 3, "the add device and the drop device"; replacing "the add device and the drop device" with - -the means for adding and the means for deflecting- -), (claim 30, line 4, "to the one fiber path"; deleting "the"), (claim 31, line 2, "devices"; replacing "devices" with - -means for adding, means for deflecting,- -), and (claim 34, line 2, "the housings"; deleting "the").

For purposes of examination, the claims have been treated as such. Appropriate correction is required.

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2. Claim 11 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 6.  
See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15, 22, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Milton et al. (US Patent 6631018).
4. Regarding claims 15, 22, and 29, Milton et al. discloses an apparatus comprising a pair of add/drop modules (Fig. 1, #4-8) corresponding to one of a plurality of channels (Fig. 3, #2 and 3), each module comprising an add device (col. 4, lines 62-63, and Fig. 3, #10) as a means for adding light to a first one of the fiber paths (Fig. 3, #2), and a drop device (Fig. 3, #11) as a means for deflecting a portion of light from a second one of the fiber paths (Fig. 3, #3), wherein the pair have identical construction and the first and second paths, corresponding to a plurality of channels, carry light in opposite directions (Fig. 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19, 26, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milton et al. as applied to claims 15, 22, and 29 above, and further in view of Strasser et al. (US Patent 5832156).

Milton et al. discloses an apparatus as recited above.

However, Milton et al. does not disclose a monitor module coupled to one add/drop module and to fiber paths, the monitor including an add coupler to add a control signal and a tap to extract a portion of light.

Strasser et al. teaches a monitor module (Fig. 11, #111) coupled to one add/drop module (Fig. 11, #112) and to fiber paths (Fig. 11, #82), the monitor including an add coupler to add a control signal (Fig. 11, #117) and a tap to extract a portion of light (Abstract).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the apparatus of Milton et al. with the monitoring module of Strasser et al., since one would be motivated to incorporate this to facilitate maintenance (Abstract) as implied from Strasser et al.

6. Claims 21, 28, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milton et al. as applied to claims 15, 22, and 29 above, and further in view of Bala et al. (US Patent 6333799).

Milton et al. discloses an apparatus as recited above.

However, Milton et al. does not disclose a client portion as a means to interface with a client station to receive and transmit optical signals.

Bala et al. teaches a client portion to as a means interface with a client station to receive and transmit optical signals (Fig. 22, #184 and 187).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the apparatus of Milton with the client portion of Bala et al., since one would be motivated to incorporate this for easier user interface in an optical communication system (Abstract) as implied from Bala et al.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 15, 21, 22, 28, 29, and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 5 of U.S. Patent No. 6,684,005. Although the conflicting claims are not identical, they are not patentably distinct from each other since the patent's claims are narrower in scope and reads on the claims of the instant application as follows.

Regarding claims 15 and 21, U.S. Patent No. 6,684,005 claims an add/drop node used in an optical network having two fiber paths for carrying light corresponding to a plurality of channels in opposite directions, comprising: a pair of add/drop modules corresponding to one of the plurality of channels, each of the add/drop modules comprising, an add device configured to add light to a first one of the fiber paths, a drop device configured to deflect a portion of the light from a second one of the fiber paths, wherein the pair of add/drop modules have identical construction and said first and second fiber paths carry light in opposite directions, and an optical client portion configured to interface with a client station to receive and transmit optical signals (Claim 1).

Regarding claims 22 and 28, U.S. Patent 6,684,005 claims an optical communication system comprising: a plurality of fiber paths that carry optical signals corresponding to a plurality of channels in opposite directions; and a plurality of add/drop nodes coupled to the fiber paths, each of the add/drop nodes comprising, a pair of add/drop modules corresponding to one of the plurality of channels, each of the add/drop modules comprising, an add device configured to add light to one of the fiber paths, and a drop device configured to deflect a portion of the light from another one of the fibers paths, and a client station coupled to one of the add/drop nodes,



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wherein the one add/drop node further comprises: an optical client portion configured to interface with the client station to receive and transmit optical signals (Claim 3).

Regarding claims 29 and 35, U.S. Patent 6,684,005 claims an add/drop node used in an optical network having two fiber paths for carrying light corresponding to a plurality of channels in opposite directions, comprising: a pair of add/drop modules corresponding to one of the plurality of channels, each of the add/drop modules comprising, means for adding light to one of the fiber paths, means for deflecting a portion of the light from another one of the fibers paths, wherein the pair of add/drop modules have identical construction; and means for interfacing with a client station to receive and transmit optical signals (Claim 5).

In conclusion, although the instant application omits various elements in its claims such as a first and second optical transmitter and receiver and are not identical to the claims of U.S. Patent No. 6,684,005, they are not patentably distinct from each other because omission of elements and its function in a combination where the remaining elements perform the same functions as before is an obvious modification, which involves only routine skill in the art.

8. Claims 19, 26, and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 5 of U.S. Patent No. 6,684,005 as applied to claims 15, 22, and 29 above, and further in view of Strasser et al.

US Patent 6,684,005 claims an apparatus as recited above.

However, US Patent 6,684,005 does not claim a monitor module coupled to one add/drop module and to fiber paths, the monitor including an add coupler to add a control signal and a tap to extract a portion of light.

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Strasser et al. teaches a monitor module (Fig. 11, #111) coupled to one add/drop module (Fig. 11, #112) and to fiber paths (Fig. 11, #82), the monitor including an add coupler to add a control signal (Fig. 11, #117) and a tap to extract a portion of light (Abstract).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the claims of US Patent 6,684,005 with the monitoring module of Strasser et al., since one would be motivated to incorporate this to facilitate maintenance (Abstract) as implied from Strasser et al.

*Allowable Subject Matter*

9. Claims 2-7 and 9-14 contain allowable subject matter.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 2, prior art does not disclose or fairly suggest an add/drop node to be connected in an optical WDM-network including add/drop modules of a second one of two sets different from a first one having their add devices connected in a second one of the two optical fiber paths and their drop devices connected in a first one of the two optical fiber paths, in combination with all the limitations in the claim. Claims 3-7 and 9-14 contain allowable subject matter by virtue of their dependency.

10. Claims 16-18, 23-25, and 30-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and all intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

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Regarding claims 16, 23, and 30, prior art does not disclose or fairly suggest an add/drop node or module including a second fixed connector attached to housing to connect to another fiber path and a second optical fiber extending from the housing and coupling to a second free connector at one end, the second free connector connecting to a neighboring add/drop module, in combination with all the limitations in each respective claim and base claim. Claims 17, 18, 24, 25, 31, and 32 contain allowable subject matter by virtue of their dependency.

11. Claims 20, 27, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and all intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 20, 27, and 34, prior art does not disclose or fairly suggest an add/drop node or module including a monitor module with an add coupler and tap having a housing that is identical to housing of add/drop modules, in combination with all the limitations in each respective claim, all intervening claims, and base claims.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 15, 19, 21, 22, 26, 28, 29, 33, and 35 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Cheng Glen Kao whose telephone number is (571) 272-2492. The examiner can normally be reached on M - F (9 am to 5 pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Glick can be reached on (571) 272-2490. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



gk



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